Supreme Court, U.S.
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No. 94-1055

IN THE
Supreme Court of the United States
OCTOBER TERM, 1994

SYSCO CORPORATION,

Petitioner,

v.

TONE BROTHERS, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITIONER'S REPLY MEMORANDUM

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The respondent's primary argument against the granting of certiorari is that it is premature for this Court now to consider the issues presented by the petition because "[t]he case has simply been remanded to the trial court for resolution of certain specifically identified questions of material fact." Br. in Opp. 3. This assertion distorts the decision of the Federal Circuit, which squarely decided, as a matter of law, that "experimentation involving the functional aspects of a product to which a design patent relates can be a non-public use." Pet. App. 40a. The

Federal Circuit claimed that "none of our cases have [*sic*] addressed the issue," and it explicitly held "today" that "experimentation directed to functional features of a product also containing an ornamental design may negate what otherwise would be considered a public use within the meaning of section 102(b)." *Id.*

In other words, the Federal Circuit panel itself recognized that its holding was more than a decision "simply" remanding a case for additional factual elaboration. The panel's determination that its ruling did not conflict with *In re Mann*, 861 F.2d 1581 (Fed. Cir. 1988), was not shared by the district court and apparently not by two of the most experienced judges on the Federal Circuit — both of whom voted to rehear this case *en banc*.

The Federal Circuit's opinion belies respondent's assertion that "[t]he present dispute is a conventional design patent infringement and trade dress case which involves no unsettled questions of law." Br. in Opp. 3. We have noted that the Federal Circuit acknowledged that it engaged in a pioneering judicial foray when it ruled on the "experimental use" question. And it also journeyed in previously uncharted waters when it concluded, notwithstanding the results of a consumer survey, that a trial had to be held to determine whether consumers believed that the spices in Tone's container came from a single source, rather than the 18 sources identified by consumers during the survey.

Respondent argues that since the court of appeals reversed the entry of summary judgment and remanded the case for the submission of more evidence, the issue we present should await "a complete record." Br. in Opp. 4-5. The record is, however, "complete" on the legal issues raised in the petition. The questions of law we have

presented for resolution by this Court do not require the expenditure of substantial additional resources of the lower courts and of lawyers.

Respondent seeks to have certiorari denied whenever a court of appeals reverses a district court's grant of summary judgment. In fact, this Court has reviewed cases presented in a parallel posture, and it has reversed the court of appeals' reversal of summary judgment. *Campbell v. Acuff-Rose Music, Inc.*, 114 S. Ct. 1164 (1994), for example, was a case in which the district court had granted summary judgment on the ground that parody was "fair use" under the Copyright Act. The court of appeals had then reversed and sent the case back to the district court for trial. *Acuff-Rose Music, Inc. v. Campbell*, 972 F.2d 1429 (6th Cir. 1992). This Court granted certiorari before the trial court's remanded proceeding and reversed. It could have been said there — as respondent is arguing here — that this Court should wait until after the end of the trial following remand. But this Court sustained the petitioner's claim that the court of appeals' reversal and remand was wrong as a matter of law.

The *United States Reports* contain other cases in which this Court granted certiorari even after the court of appeals reversed a grant of summary judgment and remanded the case for trial. See, *e.g.*, *South Carolina v. Catawba Indian Tribe*, 476 U.S. 498 (1986); *Air France v. Saks*, 470 U.S. 392 (1985).

In this case, as well, there is no substance whatever to the contention that the Federal Circuit's decision should be immunized from review because the court of appeals contemplated some future action by the lower court. The issues now being presented to this Court do not depend on

facts to be established in any remanded proceedings. There is, therefore, no reason to delay review of the important and "interesting" (Br. in Opp. 9) issues raised by the petition.

Finally, we request again that the Solicitor General be invited to express the views of the United States. Since the United States Patent and Trademark Office prevailed in *In re Mann*, it should express its view on the effect of the ruling in this case on that established precedent.

Respectfully submitted,

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